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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
KIGHT, et al. : Art Unit: 3627
Serial No: 09/892,897 / :
Filed: June 28, 2001 / : Examiner: J. Kramer
For: INTER-NETWORK FINANCIAL SERVICE

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

March 15, 2004

Siri

This Reply Brief is submitted (in triplicate) in response to the Examiner's Answer issued on January 13, 2004.

REPLY TO EXAMINER'S RESPONSE TO ARGUMENTS

In the Appellants Brief, it is argued that the applied art lacks any suggestion of the receipt of information indicating that the payee is associated with the second payment network as recited in claim 1.

Referring to the Examiner's Answer beginning with the penultimate paragraph on page 6 through the paragraph bridging pages 6 and 7, the Examiner argues that because of the use of the transitional phrase "comprising", claim 1 "does not exclude the transmitting of a payment instruction from the first payment service provider to the second payment service provider, via a third party intermediate to make the payment to the payee as taught by Thomas, et al." The Examiner goes on to assert that "since

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Applicant does not expressly indicate in the method step of Claim 1, who receives the information indicating that the payee is associated with the second payment network and since it is not implicit that the first service provider receives this information, the Examiner is not required to address this interpretation of the limitation. As such, the Examiner reaffirms the position stated in the Final Office Action, the TTP receives the information indicating the payee's association with the second payment network. In addition, it is inherent and necessarily present to the teaching of Thomas, et al. that a payment instruction from the first bank (service provider) to the second bank (service provider) is transmitted through the TTP to make payment to the payee. Examiner knows of no other way to make this payment electronically without a payment instruction."

The Examiner's position is not understood. As noted above, the Examiner asserts that "Applicants claim does not exclude the transmitting of a payment instruction from the first payment service provider to the second payment service provider via a third party intermediate."

However, contrary to the Examiner's contention, according to Thomas, et al. no payment instructions are transmitted between first and second payment service providers (i.e., according to the Examiner's construction of Thomas's, et al. first and second banks) via a third party intermediate (i.e., the TTP according to the Examiner). Rather, Thomas, et al. lacks any disclosure of a payment instruction being transmitted via a third party intermediate to the second bank. The only transmission of a payment instruction according to Thomas, et al. is from the first bank (i.e., the payer bank) to the TTP. Indeed, in Thomas, et al. there is no need for a transmission of a payment

instruction from the first bank to the second bank. Furthermore, to the extent that an argument can be made that the transfer of funds in Thomas, et al. between the TTP and the payee bank corresponds to a payment instruction, this ACH transfer is not transmitted from the payer bank, and hence does not correspond to a payment instruction transmitted from the first payment service provider as explicitly required by claim 1.

Accordingly, even if one could construe Thomas, et al. as transmitting a payment instruction from the payer's bank to the TTP and a payment instruction from the TTP to the payee bank, the payment instruction transmitted by the TTP to the payee bank would not be the same payment instruction transmitted by the payer bank to the TTP (i.e., there is no pass through).

Hence, the Examiner has supported the rejection of claim 1 based on a misinterpretation of the teachings of the applied prior art. It is respectfully submitted that while the Examiner asserts that it is inherent and necessary to Thomas, et al. that a payment instruction be transmitted from the first bank to the second bank through the TTP, this is not and indeed is contrary to what Thomas, et al. itself discloses. Indeed, another way to make payment electronically without a payment instruction from the first payment service provider or first bank to a second service provider or second bank, as required by claim 1, is expressly taught by the applied Thomas, et al. reference.

Furthermore, construing claim 1 to include the transmission of the payment instruction from the first payment service provider to the second payment service provider via an intermediate, requires that the first service provider have information indicating that the payee is associated with the second payment network. The

Examiner contends that he is not required to address this implication or inherency in claim 1. It is respectfully submitted that this failure to consider an express limitation in the claim is improper both procedurally and substantively. Indeed the Examiner completely ignores this limitation and has failed to identify any suggestion within Thomas, et al. or provide any reasonable rationale as to how the receipt of such information could be considered obvious in view of the applied prior art.

As discussed in detail in the Appeal Brief, a primary objective of Thomas, et al. is to avoid identifying the payee bank to the payer bank. It is inherent that in order for the payer bank to transmit a payment instruction to the payee bank, the payer bank must be informed of the identity of the payee bank. Hence, in order to modify Thomas, et al. to include the required transmission of a payment instruction from a first to a second payment service provider as required by claim 1, would result in Thomas, et al. violating its own objective.

The Examiner contends that, because of the use of the transitional phrase "comprising", the argument in the Appeal Brief which evidences that "in Thomas, et al. there is no, and there is no need for, transmission of a payment instruction from the first bank to the second bank to make the payment to the payee is moot [not mute]" (see the first full paragraph on page 7 of the Examiner's Answer). However, the use of the transitional phrase "comprising" does not in anyway make moot what Thomas, et al. expressly discloses or what claim 1 requires.

Turning now to independent claim 27, the Examiner asserts in the second full paragraph on page 7 of the Examiner's Answer that "Examiner also applies the above argument to the independent apparatus 27 and notes that if the method for performing

a task is rejected, so too is the apparatus for performing that method". The Examiner's position is not understood.

Claim 27 recites limitations different from those recited in claim 1. Hence, in claim 27 a first payment processing station associated with a first payment network is configured with the logic to receive information indicating that the payee is associated with the second network and to transmit a payment instruction to the second payment network to make the payment to the payee. Also recited is a second payment processing station associated with the second payment network and configured to receive the transmitted payment instruction.

Hence, it is unclear how the Examiner's positions asserted in support of the rejection of claim 1 (i.e., that claim 1 does not require that the payer bank receive information indicating that the payee is associated with the payee bank) can be asserted in support of the rejection of claim 27. Furthermore, it is respectfully submitted that the requirement that the first payment processing station transmit a payment instruction to the second payment network and that a second payment processing station associated with the second payment network receive the transmitted payment instruction is not in anyway suggested by the applied Thomas, et al. reference, and the Examiner has failed to identify any disclosure within Thomas, et al. that could support a contrary conclusion.

It is respectfully submitted that here again the Examiner attempts to reject claims with different limitations in an omnibus fashion which is neither proper under the rules of examination nor supportable under law.

The Appeal Brief asserts that there is no motivation to modify the teachings of the applied Thomas, et al. reference as proposed by the Examiner, because to do so would be contrary to Thomas's, et al. own explicit teachings and would render Thomas, et al. incapable of accomplishing its stated purpose.

The Examiner's sole response is that the rejection is proper because of "Applicant use of the non-limiting transitional phrase "comprising" in the preamble of the independent claims". The Examiner's position is not understood. Irrespective of whether or not the claims are open ended or close ended, what is relevant here is that the applied art cannot be, without violating its own objective, modified to correspond to the positive recitals within the claims.

As noted on page 38 of the Appeal Brief, numerous dependent claims, which have been previously rejected without any support having been provided by the Examiner, further and independently distinguish over the applied prior art.

On pages 8-12 of the Examiner's Answer, the Examiner now asserts an alleged justification for the rejections. However, in many cases the Examiner's asserted rationale makes no sense and cannot be understood. Indeed in many cases the basis asserted in support of the rejection appears to ignore or disregard explicit teachings within the applied prior art or explicit recitations within the claims.

Referring first to claims 3 and 29, each of these claims requires that the received information indicating that the payee is associated with the second payment network be stored and include a received unique identifier. In the case of claim 29, it is also required that this storage be performed by the first payment processing station (i.e., the station which receives the payer's request to make payment to the payee and which

transmits the request to determine the payment network with which the payee is associated).

The Examiner somehow contends that because of the use of the transitional phrase "comprising" and the applied art's teachings that the TTP determines, based on a unique ID, the name and address of the payee and the RTN of the second bank, somehow Thomas, et al. suggests the recited claim limitations.

The Examiner's rationale is simply not understood. It is respectfully submitted that Thomas, et al. lacks any disclosure, and the Examiner has failed to identify any relevant disclosure within Thomas, et al., which could possibly suggest to the recited limitations of claims 3 and 29.

Claims 6 and 32 require the identification of one or more of the multiple payment networks as candidate payment networks with which the payee may be associated based upon the transmitted request, and the transmission by the inter-network directory provider or, in the case of claim 32 by the inter-network directory station, of information indicating one or more identified candidate payment networks. In the case of claim 6, this information is transmitted to the first payment service provider. In the case of claim 32, the first payment processing station is configured to receive this information.

In rejecting claims 6 and 32, the Examiner points to column 5, lines 5-15 of Thomas, et al. as teaching the generating of a database at the TTP and the distribution of this database to the home banking system (or first payment service provider). However, the Examiner fails to point to any disclosure within Thomas, et al. which in anyway suggest the identification of candidate payment networks with which a particular payee may be associated based upon a transmission of a request to identify such an

association. Indeed, as discussed above, Thomas, et al. explicitly avoids any disclosure of the bank or payment network, with which a payee is associated, being identified to the payer's bank.

Claims 7 and 33 further require that a request be transmitted to the second payment service provider to determine if the payee is associated with the second payment network. That is, where the second payment network is identified as a candidate payment network, a further transmission is made to the second payment service provider (or station) to determine if the payee is associated with that payment network.

The Examiner relies on the use of the transitional phrase "comprising" and an unsupported assertion that the required limitations can be performed by the TTP of Thomas, et al., in support of the rejection.

The basis for rejection makes no sense, and therefore can not be understood.

Claims 8 and 34 require that either the second payment service provider or second payment processing station identify the payee as a candidate payee associated with the second payment network and determine if the payee is the applicable payee.

Here again, the Examiner points to column 5, lines 5-15 of Thomas, et al. and the identification, by the TTP of Thomas, et al., of the correct payee based on a unique identifier, as somehow suggesting the required limitations.

However, the reference text in Thomas, et al. (as well as the remainder of Thomas's, et al. disclosure) is completely lacking any suggestion of candidate payees. Furthermore, Thomas, et al. utilizes a unique identifier to identify the payee bank, and

therefore lacks any need to identify candidate payees. Hence the rejection makes no sense and can not be understood.

Claims 9 and 35 are rejected on similar grounds to those asserted with respect to claims 8 and 34, and therefore also can not be understood in view of the recited limitations.

In rejecting claims 10 and 36, the Examiner contends that Thomas's, et al. disclosure in column 8, lines 55-57 that the payer's bank determines the unique identifier of the payee based on the payee name and address information, somehow suggests the claim limitations.

However, as discussed above, Thomas, et al. lacks any suggestion of identifying candidate payees, and hence has no need for the determination required by the subject claims. Accordingly, the rejection cannot be understood.

According to claims 11 and 37, a further request is sent to a third payment service provider or third payment processing station associated with the third payment network to determine if the payee is associated with the third payment network.

The Examiner contends that the claim speaks to the development of the TTP database, although the Examiner provides no insight into the basis for this contention. The Examiner further relies on Thomas's, et al. disclosure in column 16, lines 40-45, as somehow suggesting the required limitations.

However, as discussed above, Thomas, et al. lacks any teaching or suggestion of identifying candidate payment networks, and accordingly lacks any disclosure whatsoever relating to the recited limitations of the subject claims. Hence, the rejection appears to make no sense and cannot be understood.

Claims 12 and 38 require that information received from the inter-network directory provider or inter-network directory station include information indicating that the second payment service provider or second payment processing station associated with the second payment network requires secure communications.

The Examiner points to column 21, lines 43-51, of Thomas, et al. as somehow suggesting such a limitation.

However, as discussed above, the first bank of Thomas, et al. never communicates with the second bank of Thomas, et al., and accordingly has absolutely no need to receive information from the inter-network director provider of the type recited in the subject claims. Accordingly, the asserted basis for the rejection makes no sense, and the rejection cannot reasonably be understood.

Claims 13 and 39 require that the received information indicating that the payee is associated with the second payment network is a positive declaration that the payee is associated with such a network. In the case of claim 39, the received information is the information received from the second payment service provider and in the case of claim 39, the received information is that received from the second payment processing station by the first payment processing station.

The Examiner again relies on Thomas's, et al. disclosure in column 16, lines 40-55 as somehow suggesting the required limitations. However, the referenced text lacks any suggestion of the required limitations. Hence, the asserted basis for the rejection makes no sense and cannot be understood.

Claims 14 and 40 require that the inter-network directory provider or station store information indicating a network path over which to communicate with a certificate

authority. These claims also recite various other limitations on the information associated with each of the multiple payment networks.

The Examiner fails to cite any disclosure within Thomas, et al. or provide any clear rationale in support of the continued rejection of these claims. Rather the Examiner simply makes general statements regarding Thomas's, et al. database and the TTP, which are unrelated to the required limitations. Accordingly, the basis for the rejection cannot be understood.

Claims 15 and 41 and 16 and 42 are also rejected without reference to any specific disclosure within the applied prior art, and cannot be reasonably understood.

Claims 17 and 43 require that the inter-network directory provider or station store information for each of the multiple payment networks indicating associations between its payment service provider and its payees. Also required is that the received information indicating that the payee is associated with the second payment network be received from the inter-network directory provider or station and be a positive determination that the payee is associated with the second payment network. The Examiner relies on Thomas's, et al. disclosure in column 5, lines 5-15, as suggesting the required limitations.

However, the reference text lacks any such suggestion. Furthermore, any modification of Thomas, et al. to meet the required limitations would be contrary to Thomas's, et al. stated objectives.

Claims 18 and 44 require that the request to determine the payment network with which the payee is associated is transmitted to the second payment service provider, or the second payment processing station.

The Examiner relies on Thomas's, et al. disclosure in column 16, lines 40-55, relating to the TTP request for payee information from participating banks as somehow suggesting the required limitations.

However, the reference text lacks any suggestion of the recited limitations. Furthermore, the limitations are contrary to Thomas's, et al. own objectives.

Claims 19 and 45 require that the request to make the payment on behalf of the payer be received from a third payment service provider.

The Examiner refers generally to Thomas's, et al. disclosure in column 15, lines 45-50, but identifies nothing within the applied art's disclosure, which would suggest the limitations of the subject claims. Accordingly, the rejection cannot be understood.

In rejecting claims 22 and 48, the Examiner fails to identify any specific disclosure within Thomas, et al., or provide any rationale which could reasonably support the rejection. Accordingly, the rejection cannot be understood.

In rejecting claims 24, 25, 50 and 51, the Examiner again provides nothing more than general statements in support of the rejection. The Examiner points to a transmission of remittance information from the TTP to the payee, but fails to identify any disclosure within Thomas, et al., which would suggest the transmission of remittance advice from the first payment service provider (i.e., the payer's service provider) to the second payment service provider (i.e., the payee's payment service provider), as required by the claims.

Claims 26 and 52 require that a determination be made at the second payment service provider or second payment processing station as to whether or not the payment instruction will be acceptable.

The Examiner offers nothing more than general statements in support of the rejection of these claims. Accordingly, the rejection cannot be understood.

In view of the above, it is again respectfully submitted that the Examiner has denied Applicants their due process rights, has failed to establish a *prima facie* basis for the rejection, has proposed modifications to the applied art which are unmotivated, has failed to apply art which teaches or suggests the claimed invention, and has, at best, improperly reconstructed the invention based on the present disclosure.

Thus the rejection of the pending claims is in error, and reversal is clearly in order, and is courteously solicited.

To the extent necessary, Applicants petition for an extension of time under 37 CFR § 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account No. 01-2135 (Case No. 1158.41335X00) and please credit any excess fees to such Deposit Account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP



Alfred A. Stadnicki
Registration No. 30,226

1300 North Seventeenth Street
Suite 1800
Arlington, VA 22209
Tel.: 703-312-6600
Fax.: 703-312-6666

AAS/slk